

REMARKS

This responds to the Office Action mailed on December 27, 2007.

Claims 1, 9, 13, 24, 29 and 30 are amended, no claims are canceled, and no claims are added; as a result, claims 1-30 are now pending in this application.

§103 Rejection of the Claims

Claims 1-7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Talvitie (U.S. 6,791,491 B2).

Claims 13 and 17-21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over McGeehan et al. (U.S. 6,229,992 B1) in view of Talvitie (U.S. 6,791,491 B2).

Claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Talvitie (U.S. 6,791,491 B2) as applied to claim 1 above, and further in view of Sugar et al. (U.S. 2002/0080728 A1).

Claims 9-10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Talvitie (U.S. 6,791,491 B2) in view of McGeehan et al. (U.S. 6,229,992 B1).

Claim 11 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Talvitie (U.S. 6,791,491 B2) in view of McGeehan et al. (U.S. 6,229,992 B1) as applied to claim 9 above, and further in view of Rose, Jr. (U.S. 5,127,101).

Claim 14 was rejected under 35 U.S.C. § 103(a) as being unpatentable over McGeehan et al. (U.S. 6,229,992 B1) in view of Talvitie (U.S. 6,791,491 B2) as applied to claim 13 above, and further in view of Loo et al. (U.S. 5,757,319).

Claims 15-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over McGeehan et al. (U.S. 6,229,992 B1) in view of Talvitie (U.S. 6,791,491 B2) as applied to claim 13 above, and further in view of Sengupta et al. (U.S. 6,556,102 B1).

Claim 22 was rejected under 35 U.S.C. § 103(a) as being unpatentable over McGeehan et al. (U.S. 6,229,992 B1) in view of Talvitie (U.S. 6,791,491 B2) as applied to claim 21 above, and further in view of Stolarczke et al. (U.S. 5,093,929).

Claim 23 was rejected under 35 U.S.C. § 103(a) as being unpatentable over McGeehan et al. (U.S. 6,229,992 B1) in view of Talvitie (U.S. 6,791,491 B2) as applied to claim 21 above, and further in view of Young et al. (U.S. 6,643,522 B1).

Claims 24 and 26-30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Talvitie (U.S. 6,791,491 B2) in view of McGeehan et al. (U.S. 6,229,992 B1).

Claim 25 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Talvitie (U.S. 6,791,491 B2) in view of McGeehan et al. (U.S. 6,229,992 B1) as applied to claim 24 above, and further in view of Sugar et al. (U.S. 2002/0080728 A1).

However, since a *prima facie* case of obviousness has not been established by the Office Action in each case, the Applicant respectfully traverses the grounds of rejection of these claims.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*¹. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be considered. MPEP 2143.03. “All words in a claim must be considered in judging the patentability of that claim against the prior art.”

2) Application of § 103 to reject claims - Combining the references does not supply all claimed elements:

Claims 1 and 9:

Amended independent claims 1 and 9 recites in part, “**periodically transmitting a test signal** over a channel affected by interference from **an interference signal associated with a transceiver, the test signal transmitted when the transceiver is not transmitting or receiving operational signals** and the test signal sampled from the interference signal” (emphasis added). Talvitie does not disclose the above element.

In contrast to claim 1, which applies a test signal to a channel affected by interference, Talvitie pertains to testing when the device is manufactured and access of external signals is eliminated, stating:

The correct attenuation value for the adjustment block 8 and delay for the delay block 9 can be determined experimentally when the electronic device is manufactured. Thus advantageously a test environment is used in which access of external radio frequency signals to the second antenna 5 can be eliminated. (See col. 5, lines 10-12).

¹ 837 F.2d 1071, 1074, 5 U.S.P.Q.2d (BNA) 1596, 1598 (Fed. Cir. 1988)

Applicant is unable to find any teaching in Talvitie the above elements of claim 1. As a result, Talvitie does not disclose or suggest all the elements of amended independent claim 1. Therefore, a *prima facie* case of obviousness has not been established and applicant respectfully requests reconsideration and the withdrawal of the rejection, and an allowance of amended independent claim 1.

Claims 2-8 depend either directly or indirectly from amended independent claim 1. These dependent claims inherit the elements of base claim 1, and are therefore allowable for the same reasons as discussed above with respect to independent claim 1. Claims 10-12 depend directly from claim 9 and inherit the elements of base claim 9, and therefore for at least the reasons stated herein are allowable. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 1-8, and 9-12 and allowance of these claims.

Claim 13:

For at least the reasons similar to those discussed above with respect to claims 1 and 9, Applicant submits that amended independent claim 13 is patentable over Talvitie. Additionally, McGeehan does not teach or suggest the elements of claim 13 missing in Talvitie. Specifically, nowhere in McGeehan is there a teaching of “a transceiver configured to periodically transmit a test signal to propagate from the first signal path to the second signal path when the transceiver is not transmitting or receiving operational signals.” Applicant submits that Talvitie and McGeehan either alone or in combination do not teach or suggest all the elements of claim 13. Thus, Applicant submits that claim 13 is patentable over Talvitie and McGeehan. Claims 14-23 either directly or indirectly depend from claim 13 and inherit the elements of base claim 13, and therefore for at least the reasons state herein, are allowable.

Applicant respectfully requests reconsideration and withdrawal of these rejections of claims 13-23, and allowance of these claims.

Claim 24:

For at least the reasons similar to those discussed above with respect to claims 1 and 9, Applicant submits that amended independent claim 24 is patentable over Talvitie. Additionally, McGeehan and Young do not teach or suggest the elements of claim 24 missing in Talvitie.

Applicant submits that Talvitie, McGeehan and Young either alone or in combination do not teach or suggest all the elements of claim 24. Thus, Applicant submits that claim 24 is patentable over Talvitie, McGeehan and Young. Claims 25-30 either directly or indirectly depend from claim 24 and inherit the elements of base claim 24, and therefore for at least the reasons state herein, are allowable.

Applicant respectfully requests reconsideration and withdrawal of these rejections of claims 25-30, and allowance of these claims.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6970 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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By

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 28th day of April 2008.

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